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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,686	12/30/2003	Mitchell S. Steiner	P-2769-US9	2903

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EXAMINER	
FUBARA, BLESSING M	

ART UNIT	PAPER NUMBER
1618	

MAIL DATE	DELIVERY MODE
12/11/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/747,686	STEINER ET AL.	
	Examiner	Art Unit	
	BLESSING M. FUBARA	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 September 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11 and 16-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11 and 16-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/17/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Examiner acknowledges receipt of request for extension of time, request for continued examination under 37 CFR 1.114, amendment and remarks, and petition for revival of the application, all filed 9/25/08. The examiner also acknowledges receipt of IDS filed 3/17/08. Claims 1-3, 7-10 and 12 are canceled. Claims 11, 16, 19, 23-26, 28 and 30-32 are amended. Claims 11 and 16-32 are pending.

The petition for revival of the application has been approved on 10/21/08.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/25/08 has been entered.

Response to Arguments

Previous rejections that are not reiterated herein are withdrawn.

Information Disclosure Statement

Applicant has submitted form PTO -892 as part of IDS. However, those references on the PTO 892 have not been considered. The references cited by the examiner in this examined application will normally be printed on the face of the issued patent. However, is applicant wants other references to be considered and to be printed on the face of the file, it is suggested that applicant submit those references on proper form PTO-1449.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 11, 16-24, 26, 28 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biegnon et al. (US 5,650,425) in view of Davidson et al., (in J. Urol. 1995, Oct, 154(4), abstract) or Nelson et al., (in Eur. Urol. 1996; 30(2): abstract) or Montironi et al., (in J. Clin. Patho, 1997, 50: 77-782).

Biegnon describes the use of composition containing antiestrogen drugs to treat cancers such as cancer of the breast, ovaries and prostate cancer; the antiestrogen drug is triphenylbutene, tamoxifen, desmethyltamoxifen, toremifene, desmethyltoremifene, clomiphene, nafoxidine, or ethamoxytriphetol; the drug or composition is used in effective amount or at about 0.01 to about 10 mg/kg in humans, the composition being formulated into tablet, pills or capsules (column 6, lines 30-33, 44-66; column 9, lines 10-12, 31-49; claims 1-39). Tablet or capsule meets claim

24, 26. Biegnon contemplates administering the composition 1-4 times a day and specifically says that the most appropriate administration will depend on the clinical indication being treated (column 9, lines 40-44) meeting claims 30-32. Biegnon also contemplates microcapsules or liquid forms of suspensions and emulsions for parenteral administration, including subcutaneous, intramuscular, intravenous and other parenteral routes (column 9, lines 20-27) meeting claims 23, 26, 28; the composition is also formulated as encapsulated pellets or depots for sustained delivery (column 9, lines 27-29) meeting claims 21, 22 and 26. The composition contains excipients such as corn starch, lactose, sucrose, sorbitol, talc, stearic acid, magnesium stearate, dicalcium phosphate and gums, with pharmaceutically acceptable diluents (column 9, lines 13-16) meeting claims 19 and 20.

Biegnon does not teach that the person being treated has premalignant lesions as required by claim 11; claims 16-18 further define what the premalignant lesions are. But it is been described that premalignant lesions (claim 1) such as PIN and HGPIN (claims 16-18) are precursors of prostate cancer according to Davidson (see the abstract), Nelson (see the abstract) and Montironi (see the whole document with emphasis on pages 775-777, 780, 781). Therefore, taking the teachings of the prior art, one having ordinary skill in the art at the invention was made would have reasonably expected that administering the composition of Biegnon to a subject would be effective in treating premalignant lesions such as PIN and HGPIN, which are all precursors of prostate cancer.

5. Claims 11, 25, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biegnon et al. (US 5,650,425) in view of Davidson et al., (in J. Urol. 1995, Oct, 154(4), abstract)

or Nelson et al., (in Eur. Urol. 1996; 30(2): abstract) or Montironi et al., (in J. Clin. Patho, 1997, 50: 77-782) and further in view of Jalonen et al. (US 5,571,534).

6. Biegnon in view of Davidson or Nelson or Montironi have been shown to render obvious claims 11, 16-24, 26, 28 and 30-32. While Biegnon teaches parenteral administration where the composition is liquid or emulsion or suspension, Biegnon does not teach that the parenteral formulation can be in the form of a liposome. But Jalonen teaches that parenteral formulation comprising toremifene can be in the form of liposome and toremifene composition can also be topically applied (abstract, column 1, lines 47-49, 59-67; column 2, lines 39-67 ad claim 1).

7. Therefore, taking the combined teachings of the references cited, one having ordinary skill in the art at the time the invention was made would reasonable expectation that formulations of toremifene or the metabolite desmethyl toremifene locally applied topically or by parenteral administration of liposomal formulation would enable the successful introduction of toremifene or its metabolite to the tumor/cancer site to achieve efficacious concentration of the drug in the disease tissue.

8. Claims 11, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biegnon et al. (US 5,650,425) in view of Davidson et al., (in J. Urol. 1995, Oct, 154(4), abstract) or Nelson et al., (in Eur. Urol. 1996; 30(2): abstract) or Montironi et al., (in J. Clin. Patho, 1997, 50: 77-782) in view of DeGregorio et al. (US 5,750,576).

9. Biegnon in view of Davidson or Nelson or Montironi have been shown to render obvious claims 11, 16-24, 26, 28 and 30-32. Biegnon teaches oral administration of the Toremifene or metabolites of toremifene formulation in the form of tablet, capsule, pill, liquids and suspension (column 6, lines 30-33, 44-66; column 9, lines 10-12, 31-49; claims 1-39), microcapsules or

liquid forms of suspensions and emulsions for parenteral administration, including subcutaneous, intramuscular, intravenous and other parenteral routes (column 9, lines 20-27) and encapsulated pellets or depots for sustained delivery (column 9, lines 27-29). Biegnon does not administer toremifene as a suppository as required by claim 27. But it is known in the art and according to DeGregorio that formulations containing toremifene metabolites can be administered in a variety of ways including orally, parenterally or transdermally using conventional forms of preparations, such as capsules, tablets, granules, powders, suppositories, injections, patches, suspensions and syrups (column 3, lines 26 and 52-65). Therefore, taking the teachings of the references, one having ordinary skill in the art at the time the invention was made would have reasonable expectation that administering the composition of Biegnon in the form or capsules, tablets, granules, powders, suppositories, injections, patches, suspensions and syrups as disclosed by DeGregorio would be effective in delivering toremifene or its metabolites; suppositories meeting the requirements of claim 27.

Double Patenting

10. Claims 11 and 16-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 7, 45 and 54-67 of copending Application No. 10/611,056. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same compositions are employed in the examined claims and the copending claims to suppress/inhibit/reduce the incidence of premalignant lesions or PIN/HGPIN.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 11 and 16-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/747,685. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed inventions are the same except that the examined application has metabolites in 11 and claims 1 and 2 of the co-pending application does not recite metabolites. However, later dependent claims 3-5 of the co-pending application 10/747,685 recite analog or metabolite. The claims are not identical, but are inherently the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 11 ands 16-32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims 1-17, 1-34, 1-20, 1-17, 1-19, 1-34 and 1-63 respectively of U.S. Patent Nos. 6,413,534; 6,413,533; 6,413,535; 6,410,043; 6,265,448; 6,632,447 and 6,899,888 respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because the issued claims administer triphenylethylene anti-estrogen derivatives including toremifene to treat cancer including prostate cancer such that it would have been prima facie obvious to use amount of toremifene/formula I that would be effective to reduce the risk of the incidence of developing prostate cancer in subjects having PIN.

Applicant is reminded that there are several applications and issued patents that are subject to non-statutory obviousness double patenting rejections. It is therefore suggested to applicant to file all applicable terminal disclaimers or amend the claims to obviate any

statutory double patenting in order to expedite prosecution and to avoid prosecutions in the applications rendered final in view of lack of appropriate actions from applicant.

No claim is allowed.

Response to Arguments

13. Applicant's arguments filed 9/25/08 have been fully considered but they are not persuasive.

14. Applicant has indicated that terminal disclaimer will be provided upon indication of allowable subject matter. However, the pending claims are not found allowable, the provisional obviousness type rejection will continue to be made until the rejection is overcome. Thus, since the provisional obviousness type double patenting rejection is not the only rejection in the examined application, the rejection will continue to be made until the rejection is overcome as stated in MPEP 804 [R-5], I B, that "the "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in at least one of the applications." As noted above, the provisional obviousness double patenting rejection is not the only rejection remaining in this examined application. Thus rejection is maintained and is not held in abeyance.

Applicant has also offered to file terminal disclaimers over US 6,413,534; US 6,413,533; US 6,413,535; US 6,410,043; US 6,265,448; US 6,632,447 and US 6,899,888 when allowable subject matter is identified. But the rejection is made because the rejection has not been overcome.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLESSING M. FUBARA whose telephone number is (571)272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Blessing M. Fubara/
Examiner, Art Unit 1618